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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/816,949

04/05/2004

Michael Rooke

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2406

32294

7590

10/19/2006

EXAMINER

LY, NGHI H

SQUIRE, SANDERS & DEMPSEY L.L.P.

14TH FLOOR

8000 TOWERS CRESCENT

TYSONS CORNER, VA 22182

ART UNIT

PAPER NUMBER

2617

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/816,949	Applicant(s) ROOKE ET AL.	
	Examiner Nghi H. Ly	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2617

The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-66 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 2617

4. Claims 1, 2, 4, 5, 8, 9, 11-13, 16-20, 22, 23, 26, 27, 29-31, 34-38, 40, 41, 44-46, 48, 49, 52, 53, 55, 56, 59, 60, 65 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knotts (US 6,985,748) in view of Karisson et al (US 2003/0027572A).

Regarding claims 1, 19, 37, 40, 41, 45, 60, 65 and 66, Knotts teaches a apparatus (see Abstract), the arrangement comprising: a first system entity (see fig.7, item 200 and see "2-Way SMS") providing a multimedia messaging service to user equipment connected to a network of a system (see fig.7, items 250 and/or 270 read on applicant's AN1 and/or AN2), and a second system entity providing a value added service (see column 6, lines 39-43) to a user of the user equipment via the multimedia messaging service (see fig.7, item 100 and see "2-Way SMS"), wherein the first system entity is configured to send a message to the second system entity (see fig.7, item 100 and see "2-Way SMS").

Knotts does not specifically disclose wherein the message comprises roaming information about the user equipment.

Karisson teaches wherein the message comprises roaming information about the user equipment (see [0025] and [0048]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Karisson into the system of Knotts in order to reduce paging congestion in the network (see Karisson, Abstract).

Regarding claims 2, 20, 38, 46 and 56, the combination of Knotts and Karisson further teaches the roaming information comprises a roaming status configured to indicate whether the user equipment is roaming outside a home network of the user

equipment (see Karisson, [0034]).

Regarding claims 4, 22, 27 and 48, Knotts further teaches the second system entity is configured to use the roaming information when providing a value added service to the user equipment (see column 6, lines 39-43).

Regarding claims 5, 23 and 49, the combination of Knotts and Karisson further teaches the second system entity is configured to adapt, based on the roaming information (see Karisson, [0031]).

Regarding claims 8, 26 and 52, Knotts further teaches the second system entity is configured to determine, based on the roaming information, whether the value added service is providable to the user equipment (see column 6, lines 39-43).

Regarding claims 9 and 53, Knotts further teaches the second system entity is configured to select a route or a destination of at least one multimedia message to be delivered to the user of the user equipment according to the roaming information (see fig.1, connections between mobile devices).

Regarding claims 11, 29 and 55, Knotts teaches the second system entity is configured to determine charging related information according to the roaming information and to add the charging related information to at least one multimedia message to be delivered to the user equipment (see Abstract).

Regarding claims 12 and 30, the combination of Knotts and Karisson further teaches the first system entity is configured to send the message comprising the roaming information about the user equipment to the second system entity in response to a request received from the second system entity (see Karisson, [0035] and [0048]).

Regarding claims 13 and 31, the combination of Knotts and Karisson further teaches the first system entity is configured to obtain information about a location of the user equipment from another system entity and to determine the roaming information on the user equipment according to the obtained location information before sending the message comprising the roaming information about the user equipment to the second system entity (see Karisson, [0035] and [0048]).

Regarding claims 16, 34 and 44, Knotts further teaches the first system entity comprises a multimedia messaging service center (see Abstract).

Regarding claims 17, 35 and 59, Knotts further teaches the second system entity comprises a multimedia messaging service value added service application (see Abstract).

Regarding claims 18 and 36, Knotts further teaches the user equipment comprises a mobile station (see fig.1, mobile phones 240, 250 and 260).

5. Claims 6, 7, 14, 15, 24, 25, 32, 33, 42, 43, 50, 51, 57, 58 and 61-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knotts (US 6,985,748) in view of Karisson et al (US 2003/0027572A) and further in view of Official notice.

Regarding claims 6, 24, 50, 61 and 63, the combination of Knotts and Karisson teaches claims and 19. The combination of Knotts and Karisson does not specifically disclose the second system entity is configured to encrypt or decrypt at least part of the content of the at least one multimedia message to be delivered to the user equipment according to the roaming information. However, the examiner takes Office notice that

such feature as recited is very well known in the art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above teaching of the Knotts and Karisson for providing a method as claimed, for encrypting or decrypting the multimedia message.

Regarding claims 7, 25, 51, 62 and 64, the combination of Knotts and Karisson teaches claims 1, 19, 37, 45 and 60. The combination of Knotts and Karisson does not specifically disclose the second system entity is configured to use digital rights management to perform the encryption or decryption by using digital rights management. However, the examiner takes Office notice that such feature as recited is very well known in the art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above teaching of the Knotts and Karisson for providing a method as claimed, for encrypting or decrypting the multimedia message.

Regarding claims 14, 15, 32, 33, 42, 43, 57 and 58, the combination of Knotts and Karisson teaches claims 1, 19, 37 and 45. The combination of Knotts and Karisson does not specifically disclose the message comprising the roaming information on the user equipment is an MM7 interface message. However, the examiner takes Office notice that such feature as recited is very well known in the art.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above teaching of the Knotts and Karisson for providing a method as claimed, for providing another way to transmit message in the 3GPP.

6. Claims 3, 10, 21, 28, 39, 47 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knotts (US 6,985,748) in view of Karisson et al (US 2003/0027572A) and further in view of Elizondo (US 6,917,813).

Regarding claims 3, 21, 39 and 47, the combination of Knotts and Karisson teaches claims 1, 19, 37 and 45. The combination of Knotts and Karisson does not specifically disclose the roaming information comprises an address of a switching centre which the user equipment is using.

Elizondo teaches the roaming information comprises an address of a switching centre which the user equipment is using (see column 2, lines 18-21).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Elizondo into the system of Knotts and Karisson in order to provide SMS service when different SS7 signaling networks are in use (see [0012]).

Regarding claims 10, 28 and 54, the combination of Knotts, Karisson and Elizondo further teaches the second system entity is configured to determine a location of the user equipment (see Elizondo, Abstract and column 2, line 66 to column 3, line 2) according to the address of the switching center that the user equipment is using and provide the user equipment with information relating to the determined location (see Elizondo, column 2, lines 18-21).

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi H. Ly whose telephone number is (571) 272-7911. The examiner can normally be reached on 8:30 am-5:30 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (571) 272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nghi H. Ly

